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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,966	03/19/2002	Hiromi Ukai	62807-015	7234
7590 McDermott, Will & Emery 600 13th Street, N.W. Washington, DC 20005-3096			EXAMINER CARLSON, JEFFREY D	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 01/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/099,966

Applicant(s)

UKAI ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 13, 15, 17, 29, 31-35, 37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 13, 15, 17, 29, 31-35, 37, 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the paper(s) filed 10/31/07.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 11, 13, 17, 29, 31-35, 37, 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 11 (section (2) vs. (3)(e)-(f)) appear to substantially overlap with each other, making it unclear the difference between each sections. Has applicant repeated a limitation? Or is the scope if the limitation being further limited? Care should be taken to amend the claim to clearly further limit the sections so that limitations are not duplicated, but rather further limited.
- Claim 13 (section (3)(f)-(h) vs. section (2)) has similar problems as in claim 11 above.
- Claim 17 section (8) is confusing in that the history is one apparently of issuances, yet is updated with uses. Applicant should apparently specify that the history is one of issuances and uses.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11, 13, 15, 17, 29, 31-35, 37, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector in view of Landesmann (US20030158776) further in view of Kitsukawa et al (US6282713).

Regarding claims 11, 13, 15, 17, Spector teaches a user's TV receiving device that receives broadcasted/transmitted television content including a commercial. The customer is given the chance to request a coupon for the product offered in the commercial and he may make such a request using the remote control [para 32]. The presence of the commercial itself represents coupon information that a coupon request can be made. The request includes an identification of the product, viewer profile information and timing information and what specific commercial was being shown at the time [para 16, 22, 30, 33]. A coupon is then retrieved from coupon storage and issued based on the request [37]. A central host computer also monitors the number of coupon responses (requests) and redemptions in order to manage and nimbly makes changes to the coupon campaign operations [para 23, 24, 34, 35, 39]. The steps of reactively modifying a particular product's coupon campaign based upon collected coupon usage (responses and redemptions) inherently provides a calculation regarding the number of issuances and redemptions for that product/commercial's coupons. As

the coupon requests are tied to a specifically identified product commercial (using embedded identification information), it can be said that Spector calculates a number of issued coupons for the commercial message on the basis of the extracted identifier. Regarding the “determining a period, number of times or a fee, for the broadcasting or transmitting of the program or commercial message”, the ability to calculate a number of issuances of coupons inherently provides a number of minimum times that the corresponding commercial was broadcasted and/or viewed, therefore meeting this limitation. Spector does not teach how advertisers are charged for their advertising.

Landesmann teaches electronic advertising deliverable through interactive television where advertisers can be charged based on number of messages delivered, or number of consumer actions” such as clicks on banners (i.e. requests), redeemed coupons, number of purchases [0156]. This dynamic fee system enables advertisers to pay for advertising that is providing value to the advertiser (i.e. action are taken by interested users) rather than merely paying for advertising delivered that may not actually be seen by users or may simply be advertising that is ignored by users. It would have been obvious to one of ordinary skill at the time of the invention to have billed the advertisers of Spector in such a manner. **Kitsukawa et al** also teaches delivery of electronic coupons to users via broadcast television content. Kitsukawa et al teaches that the user can be notified of the availability of a coupon, that the user can select the coupon and that the system will store information concerning the broadcasted content when the coupons were delivered - program title, program description, air date/time and channel [11:48-54]. Upon redemption, this data is accessed and the central host includes storage of these coupon identifiers along with the broadcast content information [12:9-

20] to allow for "statistical television data." It would have been obvious to one of ordinary skill at the time of the invention for Spector to have included this data with the coupon request to that coupon requests as well as redemptions can be tied to particular advertisements and that advertisers can be charged accordingly for the user "actions" associated with their coupons and associated broadcasted commercials/programs. While Spector includes a relay server that inserts additional information about the user and the originating program, the user receivers or Spector must inherently have some sort of show coding/identification of the channel, name, date/time so that the relay server can know what added metadata/details to insert. It would have been obvious to one of ordinary skill at the time of the invention to have the user's receiver attach this (ultimately necessary) information to the initial coupon request. First, the user's receiver (PVR) already inherently includes all the needed information concerning the details of the broadcast (time, channel, program name). Second, the receiver (PVR) can play shows recorded earlier and in this case, the recorder must specify to the relay server what particular broadcast time, date, channel are associated as the originating commercial. Third, where this information is attached is not taken to be critical to the instant invention as applicant himself states that the information can be attached by the receiver or by another entity [see PG PUB para 0030]. What is clear to one of ordinary skill when reading the applied references is that in order for the invention to operate, the information must be provided at some point prior to issuing the coupon so that the association with the particular broadcast can be captured. Given the above teachings of Kitsukawa et al, it would have been obvious to one of ordinary skill at the time of the invention to modified Spector to collect and analyze the TV programming data which

acted as a source of the requested or issued coupons so that marketing decision makers can better understand the TV programming, TV audience behavior, and their participation in the coupon campaign, in order to optimize future coupon campaigns. It would have been obvious to one of ordinary skill at the time of the invention to have collected statistical television data as suggested by Kitsukawa et al in order to determine the relative success of the coupons (number of requests, number of redemptions, elapsed time before redemption) for each of the associated broadcasts in order to provide basic Marketing insight, especially as Spector notes desires for demographic and regional analysis and applicant has indicated that audience rate of a broadcast program has conventionally been used [spec page 2 lines 10-12].

Regarding claim 29, Spector's user ability to see a coupon offer and then (even at a later time) request the coupon to be delivered inherently requires Spector's broadcast signal to include a coupon identifier so that the proper requested coupons are issued to the proper users. Further however, Kitsukawa et al teaches that several coupons can be available at a single time for a TV viewer. Kitsukawa et al provides storage of coupons by way of pointers that enables the plural coupons to be managed and more specifically to be uniquely identified [col 6 lines 5-13]. It would have been obvious to one of ordinary skill at the time of the invention to have inserted a coupon identifier at the host of Spector so that the programs/commercials can be broadcasted with embedded coupon identifiers, allowing users to accurately identify desired coupon when plural coupons are shown at the same time.

Regarding claims 31, 35, 38, Spector teaches that demographic profile information is sent as part of the request [para 22, 30, 33] and that this demographic

profile information is used to target the coupon. Spector also mentions that it is known to analyze television-delivered coupons to determine usage of the coupons and the demographics of usage [0013]. Spector also teaches that coupons requested via the television system can be analyzed according to how the product is selling in a particular area or to a defined consumer group/segment. Spector however does not specifically teach gender or age. However, Official Notice is taken that it is well known to collect demographic information (including gender, age and other characteristics) about coupon users (as well as television viewers) in order to provide insight to the coupon (and TV) behavior of various demographic segments. It would have been obvious to one of ordinary skill at the time of the invention to have determined the coupon and/or TV behavior of various demographically-segmented users' according to their regions (obvious that time zone of program can define a region) of Spector in order to use the gained knowledge for better marketing decisions when dealing with these groups of consumers. Regarding the times of the issuances and redemptions, Spector teaches that the coupon offers are short life coupons which indicates the need to calculate redemption-issue times to verify the validity of the short-life coupon. Further, the dynamic nature of Spector's system that adapts according to recent coupon issuances and redemptions inherently requires time/date-indications of the coupons' issuances and redemptions.

Regarding claims 32, 33, Kitsukawa et al teaches that program content is classified (i.e. identified) by the receiver's electronic program guide (EPG) [col 5 lines 32-35]. It would have been obvious to one of ordinary skill at the time of the invention to have used such identification data in order to notify the host of the program being

watched in association with the requested coupon in order to enable the statistical analysis of uniquely identified coupons and related programming as desired by Kitsukawa et al.

Regarding claims 34, 37, Landesmann teaches that a coupon campaign may include a threshold specifying the number of advertisements to be issued overall [0156]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such a limit with that of Spector so that the provider of the advertised coupons does not over-extend his campaign offers.

6. Claims 34, 37 are alternately rejected under 35 U.S.C. 103(a) as being unpatentable over Spector, Landesmann (US20030158776) and Kitsukawa et al (US6282713) as above and further in view of Lemon et al (US4674041).

Regarding claims 34, 37, Lemon et al teaches that a coupon campaign may include a threshold specifying the number of coupons to be issued overall [2:13-20]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such a limit with that of Spector so that the provider of the coupons does not over-extend his offers.

Response To Arguments

Applicant's arguments are moot in view of the newly applied references discussed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner
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